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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,489	01/03/2006	Thomas Lederer	2003P07074WOUS	8264
22116 7590 02/27/2009 SIEMENS CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 170 WOOD AVENUE SOUTH ISELIN, NJ 08830			EXAMINER TRAN, BANGLONG	
			ART UNIT 2458	PAPER NUMBER
			MAIL DATE 02/27/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,489	Applicant(s) LEDERER ET AL.	
	Examiner BANGLONG TRAN	Art Unit 2458	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/03/2006; 03/20/2006; 10/02/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 have been canceled.
2. Claims 12- 22 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "the file name" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 is a dependent claim of claim 14, therefore it is also rejected as claim 14 above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Coppinger et al (hereinafter Coppinger), U.S Publication No. 20040158607 which is included in the IDS.

7. As to claim 12, Coppinger discloses a method for a user-based processing of an electronic message having a file attachment, the method comprising:

receiving the electronic message ([0018], lines 1-2);

modifying the electronic message by replacing the file attachment by a memory location link to a user-selected memory location in a user file system ([0016], lines 7-11); and

saving the file attachment at the user-selected memory location in the user file system ([0015], lines 10-14).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger as applied to claim 12 above and in view of Dale W. Malik (hereinafter Malik), U.S Patent No. 7003551.

10. As to claim 13, Coppinger discloses the invention as described in claim 12 above. Coppinger does not disclose creating a message link to the modified electronic message at the user-selected memory location. However, Malik discloses creating a message link to the modified electronic message at the user-selected memory location (column 4, lines 42-45).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teaching of Makik for creating a message link to the modified electronic message at the user-selected memory location. Because it would provide a better way to users to access the electronic massages without opening the email client in advance (i.e. Microsoft Outlook TM).

11. As to claim 16, Coppinger discloses the electronic message is an e-mail of an e-mail client (Fig.2, email client 52). Coppinger does not explicitly disclose the use of SMTP. However, Malik discloses the use of SMTP (column 1, lines 49-50).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teaching of Malik to have the electronic message is an e-mail of an SMTP e-mail client. Because it is the easiest and fastest way to get email from one place to another, also SMTP is very popular, it is

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supported on many platforms by many vendors, has low implementation and administration costs.

12. Claims 14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger as applied to claim 12 above and in view of Dale W. Malik (hereinafter Malik), U.S Patent No. 6898622.

13. As to claim 14, Coppinger discloses the invention as described in claim 12 above. Coppinger does not disclose the file name of the file attachment is changed when the file attachment is saved. However, Malik discloses the file name of the file attachment is changed when the file attachment is saved (column 4, lines 54-57).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teaching of Malik to have the file name of the file attachment is changed when the file attachment is saved. Because it would provide more convenient or appropriate to intended recipient of the attachment, also help users to avoid overwritten file which already existed in the storage.

14. As to claim 17, Coppinger discloses the invention as described in claim 12 above, Coppinger does not disclose the file attachment is saved according to a defined rule and/or in a set file structure. However, Malik discloses the file attachment is saved according to a defined rule and/or in a set file structure (column 5, lines 8-19).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teaching of Malik to have the file attachment is saved according to a defined rule and/or in a set file structure. Because it would provide a better way to users in order to open the file attachment base on the type, size, location or date on which the file has been saved.

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger as applied to claim 12 above, in view of Dale W. Malik (hereinafter Malik), U.S Patent No. 7003551 and further in view of Malik, U.S Patent No 6898622.

16. As to claim 15, Coppinger disclosed the invention as described in claim 12 above. Coppinger does not disclose when the message link is created the changed file name is used. However, Malik (Patent No. 700351) discloses when the message link is created (column 4, lines 42-45) and Malik (Patent No. 6898622) discloses the changed file name is used (column 4, lines 57-60).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teachings of Malik to have the feature when the message link is created the changed file name is used. Because the message link would provide a better way to users to access the electronic messages without opening the email client in advance (i.e. Microsoft Outlook TM).

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17. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger and in view of Hiroaki Sakagawa (hereinafter Sakagawa), U.S. Publication No. 20020091570.

18. As to claim 18, Coppinger discloses a device for the user-based processing of electronic message (Fig.3, client computer 102), the device comprising:

an e-mail client (Fig.3, Email Client 114) that receives an electronic message having a file attachment ([0018]. Lines 1-2);

an attachment substitution unit (Fig.3, Auto-link User Interface 108) that replaces a file attachment of a received electronic message by a memory location link ([0016], lines 7-11);

a user file system (Fig.3, Local Electronic Storage Device 110) that stores the file attachment ([0015], lines 10-14);

a control unit (Fig.3, Client Computer 102) that controls the e-mail client, the attachment substitution unit and the attachment insertion unit [0024];

inserts the replaced file attachment at a selected memory location in the user file system ([0020], lines 1-2).

Coppinger does not disclose an attachment insertion unit. However, Sakagawa discloses an attachment insertion unit (Fig.2, Advertisement Insertion Unit 204).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger with the teaching of Sakagawa to have an attachment insertion unit. Because it will provide an easier way to users to insert

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document into the email, a document could be a word document, in this case it would help users to save time without retyping the document into the email.

19. As to claim 19, Coppinger discloses the system according to claim 18, further comprising a link insertion unit (Fig.3, Auto-Link User Interface 108) that inserts a message link at the selected memory location, wherein the link refers to an electronic message with a replaced file attachment ([0016], lines 3-7).

20. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger and Sakagawa as applied to claims 18 and 19 above and in view of Malik, U.S Patent No. 7003551.

21. As to claim 20, Coppinger and Sakagawa disclose the invention as described in claims 18 and 19 above. Coppinger and Sakagawa do not disclose the inserted message includes a file name of the inserted file attachment. However, Malik discloses the inserted message includes a file name of the inserted file attachment (column 7, lines 1-2).

It would have been obvious to the one skilled in the art at the time of the invention to combine the teaching of Coppinger, Sakagawa with the teaching of Malik to have the inserted message includes a file name of the inserted file attachment. Because, It would provide users more convenient when searching for a saved attachment file.

22. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppinger and Sakagawa as applied to claims 18 and 19 above and in view of Malik, U.S Patent No. 6898622.

23. As to claim 21, Coppinger and Sakagawa disclose the invention as described in claim 18 above. Coppinger and Sakagawa do not disclose the attachment insertion unit files the replace file attachment using a modified file name. However, Malik discloses the attachment insertion unit files the replace file attachment using a modified file name (column 4, lines 54-57).

The motivation of this claim is as same as the one of claim 14 above

24. As to claim 22, Coppinger and Sakagawa disclose the invention as described in claim 18 above. Coppinger and Sakagawa do not disclose the attachment insertion unit files the replace file attachment according to a user-define rule and/or a user-define file structure. However, Malik discloses the attachment insertion unit files the replace file attachment according to a user-define rule and/or a user-define file structure (column 5, lines 8-19).

The motivation of this claim is as same as the one of claim 17 above.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ruppert et al US 20010054073

Hanna et al US 7054905

Jhingan et al US 7113948

Kirani et al US 20020116818

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BANGLONG TRAN whose telephone number is (571)270-3931. The examiner can normally be reached on Monday-Friday 8:00 a.m.-5:00p.m, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/B. T./
Examiner, Art Unit 2458

/Joseph E. Avellino/

Primary Examiner, Art Unit 2446